

REMARKS

Claims 1, 10, 16, 31 and 45 have been amended. Applicant hereby traverses the outstanding rejections and requests reconsideration and withdrawal in view of the remarks contained herein. Claims 1-21, 30-40, 45-52 and 54-60 are pending in this application.

Rejection under 35 U.S.C. § 103 (Toht in view of Shennib)

Claims 1-19, 21, 30-39, 45-47, 49, 51, 52, 54-57 and 60 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,930,856 to Toht (hereinafter, “Toht”) in view of U.S. Patent No. 5,701,348 to Shennib et al. (hereinafter, “Shennib”).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicant asserts that the rejection does not satisfy the first or third criteria.

Lack of all Claim Limitations

Claim 1, as amended, requires a connector physically coupling the behind-the-ear component to the completely-in-canal component, ...wherein the connector is designed to include a portion of the connector within the ear canal of the user. Claim 31, as amended, requires means for physically coupling the completely-in-canal component to the behind-the-ear component, ...wherein the means for physically coupling is shaped to place a portion of the means for physically coupling within the ear canal of the user. Claim 45, as amended, requires that the connector of sufficient length is shaped to place a portion of the connector within the ear canal of the user.

The Examiner asserts that Toht discloses a completely-in-canal component and a connector physically coupling the behind-the-ear component to the completely-in-canal component. Shennib is not relied upon by the Examiner as showing these limitations. Applicant respectfully disagrees with the Examiner’s characterization of element 2 of Toht as

being a completely-in-canal component as respectfully asserts that Toht does not show a connector designed to include a portion within the ear canal of the user as required by claim 1, a means for physically coupling shaped to place a portion of the means for physically coupling within the ear canal of the user as required by claim 31, or a connector shaped to place a portion of the connector within the ear canal of the user as required by claim 45.

Toht describes number 2 of Figure 1 as being a hearing aid receiver which is insertable within the ear cavity. Column 1, lines 50-53. The receiver 2 is attached to the molded element seated within the ear cavity. Column 2, lines 3-6. Toht never describes receiver 2 being inserted into the ear canal of the user, only into the outer ear cavity of the user. Therefore, Toht does not disclose a completely-in-canal component as asserted by the Examiner and required by claims 1, 31 and 45, as amended.

Further, connector element 3 of Toht, which connects elements 1 and 2, does not show a connector designed to include a portion within the ear canal of the user as required by claim 1, a means for physically coupling shaped to place a portion of the means for physically coupling within the ear canal of the user as required by claim 31, or a connector shaped to place a portion of the connector within the ear canal of the user as required by claim 45. This is evidenced by receiver 2 of Toht residing in the outer ear cavity of the user as described above, preventing the connector from extending into the ear canal of the user. Additionally, as seen in Figure 1 and column 2, lines 3-9, connector 3 is only designed to arc over the ear to connect elements 1 and 2, and is not shaped in such a manner as to allow the connector to extend into the ear canal of the user.

As Toht does not show a completely-in-canal component as asserted by the Examiner and does not show a connector designed to include a portion within the ear canal of the user as required by claim 1, a means for physically coupling shaped to place a portion of the means for physically coupling within the ear canal of the user as required by claim 31, or a connector shaped to place a portion of the connector within the ear canal of the user as required by claim 45, and Shennib is not relied upon by the Examiner as showing these limitations, Applicant respectfully asserts that the combination of Toht and Shennib does not teach all the limitations of claims 1, 31 and 45, as amended, as required by M.P.E.P. § 2143.

Applicant, therefore, respectfully requests the rejection of claims 1, 31 and 45 based on the combination of Toht and Shennib be withdrawn.

Lack of Motivation

It is well established that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Further, the proposed modification cannot change the principle of operation of the prior art invention being modified. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) cited in M.P.E.P. § 2143.01.

The Examiner acknowledges that Toht does not expressly disclose a completely-in-canal component being shaped to fit into the ear canal of the user in such a manner as to touch the bony portion of the ear canal of the user. The Examiner relies upon Shennib as teaching a completely-in-canal component of an ear mold being shaped to fit into the ear canal of the user in such a manner to touch the bony portion of the ear canal of the user. The Examiner states that it would have been obvious to insert the ear mold of Toht into the bony portion of the ear canal to provide the advantages of improved energy efficiency and high frequency response. Applicant respectfully traverses the Examiner's combination of Toht and Shennib.

As described above, Toht describes a behind-the-ear-component 1 connected by a connector 3 to a receiver 2 designed to be placed in the ear cavity. The Examiner wishes to modify Toht by inserting the ear mold of Toht into the bony portion of the ear canal. This modification, however, is not consistent with the limitations of the elements of Toht, specifically, the receiver 2 and connector 3. The receiver 2 and ear mold are designed to be placed into the ear cavity, not the ear canal as the Examiner is attempting to do. Further, the connector of Toht is designed only to bend over the top of the ear and not to be inserted into the ear canal as the Examiner's modification would require. See, Toht, column 2, lines 3-9.

If a suggested combination of references would require a substantial reconstruction and redesign of the elements shown in the primary reference as well as a change in the basic

principle under which the primary reference was designed to operate, than the combination does not render the claim obvious. *In re Ratti*, at 813, cited by M.P.E.P. 2143.01.

The Examiner's proposed changes require a substantial alteration of both connector 3 and receiver 2 of Toht. Making receiver 2 fit into the ear canal of the user, and making connector 3 connect to a completely-in-canal component would change the basic principles of operation these elements since the components disclosed by Toht are not capable of being used in such a manner without substantial alteration. Therefore, the proposed combination cannot render the rejected claims obvious under 35 U.S.C. § 103, and Applicant requests that the combination of Toht and Shennib be withdrawn by the Examiner.

Dependent Claims

Claims 2-19, 21, and 30 depend from claim 1, claims 32-39 depend from claim 31, and claims 46-47, 49, 51, 52, 54-57 and 60 depend from claim 45. Each of these claims inherit the limitations of their respective base claim and are allowable for at least the reasons described above.

Rejection under 35 U.S.C. § 103 (Toht in view of Shennib further in view of Taenzer or Rapps or Kang)

Claims 20, 40 and 50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Toht in view of Shennib and further in view of U.S. Patent No. 6,445,799 to Taenzer et al. (hereinafter, "Taenzer"). Claim 48 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Toht in view of Shennib and further in view of U.S. Patent No. 6,101,259 to Rapps (hereinafter, "Rapps"). Claims 58 and 59 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Toht in view of Shennib and further in view of U.S. Patent No. 5,757,935 to Kang et al. (hereinafter, "Kang").

Claims 20 depends from claim 1, claim 40 depends from claim 31, and claims 48, 50, 58 and 59 depend from claim 45. Each of these claims inherit the limitations of their respective base claim and are allowable for at least the reasons set forth with respect to claims 1, 31 and 45, respectively.

Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

The required fee for extension of time relative to this response is enclosed. If any additional fee is due, please charge Deposit Account No. 06-2380, under Order No. 59184/P002US/10026564 from which the undersigned is authorized to draw.

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Respectfully submitted,

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